REMARKS

It is our understanding that claims 1-20 remain pending in this application, wherein claim 20 is amended for reasons specifically remarked upon, below, and wherein claims 1-6 have been acknowledged by the Examiner as being directed to allowable subject matter.

We proceed now with reference specifically to the numbered items in the Action.

Items 1-7 and 12:

These appear informational in nature and are understood to require no reply. In Particular, we thank the Examiner for the indication of allowable subject matter in claims 1-6.

Items 8-9 (§ 112 Issues):

Respectfully, the Action is confusing. It starts by quoting 35 U.S.C. 112, ¶2 "*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*" However, this is precisely what the present claims do.

Next the Action states "*Claims 7, 8, 14, and 20 recite the limitation "*an order calculated*" in the specification, paragraph 0020 (taken from the Publication No.: 20050165798),*" which is clearly nonsensical. Perhaps the Examiner meant to say '*The claims .. and the specification at paragraph [0020] recite the limitation ....*' Next the Action states:

> *However, in the specification the terminology for "*an order calculated*" does not provide a detailed description for calculating an order based on extents lists.*
>
> *Claims 7, 8, 14, and 20 include "*an order calculated*" as a basis of a re-ordering step for the extents lists. Again, the only section of the specification that mentions "*an order calculated*" is paragraph 0020, summary of the invention There is insufficient antecedent basis for this limitation in the claims.*

Parsing this as best we can, it appears that the Examiner finds the claims here defective because:

(1) They recite the subject limitation – which they do;

(2) Because paragraph [0020] does not provide a detailed description of what that limitation means – which it does not;

(3) That the only section of the specification that mentions "*an order calculated*" is [0020] – which is incorrect; and

(4) There is insufficient "*antecedent basis*" for this limitation in the claims – which is wrongly stated and also incorrect.

With respect to (1), the Examiner is apparently indicating that he understands the claims but feels them to be unsupported by the specification. Such then, however, is not a problem in the claims, and it is not something suitable for rejection under 35 U.S.C. 112, ¶2. Rather, if correct, such would be a problem in the specification, and thus something addressable by 35 U.S.C. 112, ¶1, which states "*The specification shall contain a written description of the invention ...* [suitable] *to enable any person skilled in the art ... to make and use the* [invention]" (commonly known as the '*enablement requirement*'). In any case, we show below that there are no proper 35 U.S.C. 112, ¶¶1-2 issues here.

With respect to (2), the Examiner is correct that [0020] does not provide detailed description. It does not do so because that would be improper in the Summary Of The Invention section which [0020] is part of. As the heading suggests, [0020] contains summary rather than detailed description.

With respect to (3), the Examiner's statement is simply incorrect. For example, [0011], [0013], [0016], [0036], [0042], [0051], [0054], [0056], [0059], and [0060] explicitly discuss the order of and the re-ordering of extents lists such that a skilled artisan would clearly understand what "*re-ordering said extents lists based on an order calculated to be more efficient for execution of said plurality of queries*" means in the claims here.

With respect to (4), the phrase "*antecedent basis*" is a term of the patent art. A claim lacks or has insufficient antecedent basis when it is indefinite because it references a non-existent limitation or it makes an ambiguous reference to prior provided limitations (see e.g., MPEP 2173.05(e)). In claims 7, 8, 14, and 20 the text "*an order calculated*" is clearly not referencing an earlier recited limitation or multiple limitations. We therefore question whether the Examiner meant to say here that "*an order calculated*" is not enabled by the disclosure. In any case, the standard for both antecedent basis and enablement is whether the scope/teaching would be reasonable ascertainable by one of ordinary skill in the art, and we have shown above that this standard is met here.

Item 10 (§ 112, ¶2 Rejections):

Claims 7, 8, 14, and 20 are rejected as being indefinite. Respectfully this is error.

The Action states "*The claim limitations for claims 7, 8, 14, and 20 recite "*an order calculated*". What is this order and how is this order being calculated?*" As an initial point we

urge that our arguments above apply here as well. Next, we urge that "*an order calculated*" needs to be taken in context. For example, claim 7 recites "*re-ordering said extents lists based on an order calculated to be more efficient for execution of said plurality of queries.*"

Addressing "*What is an order.*" As is well known, an order in the context of a list is a property of the list. A list is a series of item specifications arranged in an item-by-item sequence. An order of such a list is the particular sequence of the items in it. Applicant is using "*list*" and "*order*" for their conventional meanings, confirmable by reference to virtually any dictionary.

And addressing "*how is this order being calculated.*" That is irrelevant. Applicant has no duty under § 112, ¶2 to state this in the claims, and thereby limit the scope of the claims. The spirit of the present invention is not the nature of this calculation, which is merely one small part of the claims as a whole, the invention here is the whole set of elements/limitations.

Subject to all of the other limitations, Applicant is intentionally claiming the methods of claim 7 and 8, the system of claim 14, and the computer program of claim 20 such that they encompass all possible calculations that result in more efficient execution. The fact that there is a calculation and that it results in more efficient execution are the limitations, not the specific nature of the calculation, e.g., whether it is based on any specific algorithm or on an empirical analysis. As for some examples, however, [0011], [0013], and [0016] discuss orderings with respect to the prior art and [0036], [0042], [0051], [0054], [0056], [0059], and [0060] discuss them with respect to the present invention.

Continuing, the Action states "*dependent claims 9-13 and 15-19 are also rejected as being depended on the above rejected independent claims.*" For the reasons just stated for the parent claims, we urge that these claims are also allowable.

Item 11 (Claim Objections):

The Action here states:

> *Claim 20 is objected to because of the following informalities:*
> *The preamble of independent claim 20 recites "*a computer program, embodied on a computer readable storage medium: the computer program comprising*". The examiner suggests that the applicants should kindly consider amending the preamble of independent claim 20 to further include '*...the computer program executed on a computing device comprising*'. The examiner suggests this change to the preamble because the preamble is stating that the '*computer program*' per se comprises the entire embodiment of independent claim 20. The execution of the `*computer program*' must be implemented by a*

> *'computing device' (hardware) in an effort to make the computer program and its code executable. The* 'computer program' *alone cannot cause and/or implement the actual computerized execution of this program.*
>
> *Appropriate correction is required.*

Respectfully, it appears that it has not been appreciated here that Applicant is claiming an article of manufacture rather than a machine. By claiming an article of manufacture (the computer program), any party making, using, selling, offering for sale, or importing the manufacture is a direct infringer (35 U.S.C. 271). In contrast, by claiming a conventional machine executing on a novel manufacture (a computer running the program) only users are direct infringers.

Applicant appreciates that our Courts' evolving position on the patentability of software has made the Office's job difficult. It is for this reason that claim 20 specifically recites that the computer program is "*embodied on a computer readable storage medium*," so there is no question that the article of manufacture here is tangible. And it is also for this reason that claim 20 specifically recites a "*computer program*," so there is no question here how the manufacture will be used, i.e., ultimately in a computer. It is Applicant's understanding that claim 20 more than meets the criteria currently required by the Courts.

We note that the Action here labels this an objection and requires correction. Respectfully, if our remarks above have not overcome this, we request that any future Action(s) state the Office's authority to raise such an objection.

Finally, in the course of drafting this Response we have discovered some straightforward spelling and grammar errors in claim 20. Corrective amendment is made herein.

CONCLUSION

Applicant has endeavored to put this case into complete condition for allowance. It is thought that the objections and §112 objections/rejections have all been shown to be unfounded and completely rebutted. Applicant therefore asks that all objections and rejections now be withdrawn and that allowance of all claims presently in the case be granted.

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Respectfully Submitted,

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